FERRELL & FERRELL L.L.P.
Attorneys and Counselors at Law
90 Crystal Run Road, Suite 401
Middletown, New York 10941

TELEPHONE - (703) 266-3000
FACSIMILE - (703) 266-6000

PLEASE DELIVER THE FOLLOWING FACSIMILE TRANSMISSION TO:

NAME: Examiner S.A. Acquah / Group 1711

LOCATION: USPTO

RECEIVING FAX NO.: 703-872-9311 (After Final; Technology Center 1700)

FROM: Carol R. Maddaloni

NO. OF PAGES, INCLUDING COVER SHEET: 7

DATE AND TIME: May 29, 2002

COPIES TO:

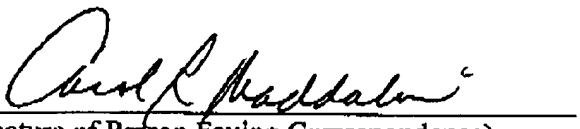
MESSAGE:

CERTIFICATE OF MAILING BY FACSIMILE (37 CFR 1.8)			Docket No.
Applicant(s): *Fiorenzo Renzi et al.*			GL-12 (GL-01-8)
Serial No. 09/830,841	Filing Date May 1, 2001	Examiner S.A. Acquah	Group Art Unit 1711

Invention: LIQUID COMPOSITION POLYMERIZABLE INTO ORGANIC GLASSES HAVING GOOD OPTICAL AND PHYSICO-MECHANICAL PROPERTIES

I hereby certify that this **Request for Reconsideration After Final Rejection Under 37 CFR 1.116** is being facsimiled to Examiner S.A. Acquah (Group 1711) at 703-872-9311and addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on May 29, 2002.

Carol R. Maddaloni
(Typed or Printed Name of Person Faxing Correspondence)



(Signature of Person Faxing Correspondence)

Note: Each paper must have its own Certificate of Mailing.

AF
#8
05-31-02
AS

IN THE UNITED STATE PATENT AND TRADEMARK OFFICE

In re Application of:

Fiorenzo Renzi et al.

U.S. Serial No. 09/830,841 — Group Art Unit: 1711

Filed May 1, 2001 — Examiner: S.A. Acquah

Docket No. GL-12 (GL-01-8)

Title: LIQUID COMPOSITION POLYMERIZABLE INTO ORGANIC GLASSES HAVING GOOD OPTICAL AND PHYSICO-MECHANICAL PROPERTIES

Assistant Commissioner for Patents
Washington, D.C. 20231

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION UNDER 37 CFR 1.116

Sir:

This is in reply to the Office Action of March 8, 2002 finally rejecting Claims 1-27 which are all the claims in the case.

Applicants wish to thank the examiner in charge of this application for the courteous telephone conversation held with Applicants' Attorney on May 23, 2002. During this conversation, the Examiner requested that any arguments Applicants'

wished to present against the outstanding rejection be submitted in written form rather than discussed at a telephonic interview.

Reconsideration of this application is respectfully requested.

Claims 1-27 have been rejected under 35 USC §102(b) as being clearly anticipated by *Renzi et al.* '293. This rejection was made previously and was argued in detail in the Amendment filed December 21, 2002. However ,the Examiner explains the repetition of this rejection in the outstanding Office Action as follows:

> The cited prior art of record in the previous communication discloses liquid glass forming composition from diallyl carbonate and diol mixture. It is Applicants' position that the cited prior art is different because "no single species, i.e., specific composition...falls within the weight percent range of polyol (c) in the mixture of aliphatic diol (B) and (C) of 5 to 20% by weight, or the molar ratio of A/B+C of 2.5/1 to 4/1". It is the Examiner's position that Applicants' argument is not convincing, and in this regard, Applicants' attention is herein directed to column 1, beginning with line 55 through column 2, line 12, and to claims 1 and 4 which clearly recite that the molar ratio (A)/(B+C) is equal to or higher than 3/1 (claim 1 recites 2.5/1 to 4/1), and the amount of (c) in the (B+C) mixture equal to, or lower than 70, preferably 20-60 as in claim 4 (claim 1 recites 5-20). Thus all the limitations of claim 1, and the remaining dependent claims are met by the disclosures of the cited prior art.

Applicants do not understand this explanation of the rejection since it is clear from the portion of the *Renzi et al.* disclosure cited by the Examiner (Col. 1, line 55 to Col. 2, line 12 and Claims 1 to 4) that no single species, i.e., specific composition which would unequivocally anticipate Applicants' claimed compositions, is identified by such disclosure. Rather, this disclosure merely describes ranges of materials which touch or overlap the claimed range. The situation involving this rejection

therefore falls squarely within the conditions described in the first part of the second section of MPEP §2103.03, Eighth Edition, which reads as follows:

> When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." What constitutes a "sufficient specificity" is fact dependent. If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims. The unexpected results may also render the claims unobvious. The question of "sufficient specificity" is similar to that of "clearly envisaging" a species form a generic teaching. See MPEP § 2131.02.

This language of the MPEP makes it clear that it cannot be concluded that Applicants' claims are "clearly anticipated" by mere perusal of the reference disclosure. Rather, it is necessary to determine whether the reference discloses the claimed subject matter, mainly the ratios of reactants utilized, with "sufficient specificity" to anticipate the claims. Relevant to this determination according to MPEP §2103.03 is whether, "if the claims are directed to a narrow range and the reference teach a broad range, there is evidence of unexpected results within the claimed narrow range." With regard to these ranges, it should be noted that Applicants' claimed range of molar ratios of diallyl carbonate to the total of diol and polyol (A/B+C) is 2.5/1 to 4/1, whereas *Renzi et al.* disclose a broad overlapping range of "equal to or higher than 3/1" and a narrower overlapping range of "3/1 to 12/1", both of which are substantially broader than Applicants' claimed range. Similarly, Applicants' claimed range of weight percent of polyol to the total of diol and polyol is 5 to 20% by weight which is much narrower than the broad range of

"equal to or lower than 70% by weight" or the narrower range "20 to 60%" disclosed by *Renzi et al.* Also relevant to the question of whether Applicants' ranges are shown with "sufficient specificity" as provided for in MPEP §2103.03 is the fact that none of the nine specific compositions disclosed by *Renzi et al.* (Examples 1-3 and compositions 1-4, 11 and 12) which react diallyl carbonate with a diol and a linear or branched aliphatic polyol containing at least three hydroxy groups, includes ranges of ratios of reactants which are within the ranges of both A/B+C and percentage of C in the mixture of B+C claimed by Applicants. More specifically, only three of the disclosed compositions (compositions 1,4 and 11) have a A/B+C molar ratio touching Applicants' maximum of 4/1, with such molar ratios of the remaining nine compositions being higher than 4/1, the highest being 12/1 (Example 2). Moreover, the percentages C/B+C of all the compositions of *Renzi et al.* prepared from compounds included in Applicants' claims, are higher than Applicants' maximum of 20%, with the lowest being 25% (compositions 1 and 2) and the highest being 50% (composition 11).

Finally, with respect to the effect of evidence of unexpected results within the claimed narrow range on the question of "sufficient specificity", mentioned in MPEP §2103.03, the attention of the Examiner is directed to the results shown in Tables 1, 2 and 3 of the specification that the compositions of the present invention can be used to make organic glasses having perceptibly better properties, e.g., of yellow index, impact strength and abrasion resistance, than the composition of *Renzi et al.*, as well as having lower shrinkage during polymerization. This would not have been predicted from the *Renzi et al.* disclosure by a person having ordinary skill in the art and is therefore an unobvious result which supports a lack of sufficient specificity in the disclosure of *Renzi et al.* necessary for a holding of anticipation under 35 USC §102.

In view of the points raised in the foregoing remarks, it is believed that this application is in condition for allowance. Such action at an early date is earnestly solicited.

Respectfully submitted,

Michael W. Ferrell
Attorney for Applicants
Reg. No. 31,158

Ferrell & Ferrell, L.L.P.
90 Crystal Run Road, Suite 401
Middletown, New York 10941
Telephone: 703-266-3000
Facsimile: 703-266-6000
May 29, 2002